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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/657,578 | 09/08/2003 | Karen M. Cregan | 0112300-1676 | 9870 |
| 29159 7590 04/09/2007 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690 | | | EXAMINER HALL, ARTHUR O | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3709 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/657,578

Applicant(s)

CREGAN ET AL.

Examiner

Arthur O. Hall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 21, 22, 42-48, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) 12-20, 23-41 and 49-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 21, 22, 42-48, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>1/31/2005; 12/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/14/2005 and 1/31/2005 have been acknowledged by the examiner. Applicant is required to submit an information disclosure statement (IDS) on PTO Form 1449 for the prior art submitted on 8/30/2004 since this IDS is missing.

Election/Restrictions

This application contains claims directed to the following patentably distinct species:

| Species | Figures | Claims |
|----------------|----------------|--|
| I | 3A-3E | (1: Generic Apparatus), (2-11, 21-22), (42: Generic Method), (43-48, 57-58) |
| II | 4A-4C | (1: Generic Apparatus), (12-20), (23-41), (42: Generic Method), (49-56) |
| III | 5A-5E | (1: Generic Apparatus), |

| | | |
|--|-------|--|
| | 6A-6E | (12-20), (23-41), (42: Generic Method), (49-56) |
|--|-------|--|

The above table includes the species and application figures along with Examiners suggested association of claims.

The species are independent or distinct because Species I is distinct from Species II and III since there exists only one set of swapping indicators which would not be capable of performing the function of two sets of swapping indicators. Examiner also believes that Species II is distinct from Species III since Species II may not generate a new rearrangement path with swapping indicators through rearrangement of symbols because the paths do not coincide. In this case, claims 12-20, 23-41, and 49-56 directed to Species II and III are broad enough to read on both species.

Examiner suggests that applicant elect a species for this restriction in the above manner because there exist four distinct claimed species of the same invention disclosed in the application. Species I is disclosed as a gaming device having essentially one set of swapping indicators and a single rearrangement path. Species II is disclosed as a gaming device and method having essentially two sets of swapping indicators where each set is in connection with a single rearrangement path and the rearrangement paths with respective swapping indicators are non-overlapping. Species III is disclosed as a gaming device and method having essentially two sets of swapping

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indicators where each set is in connection with a single rearrangement path and the rearrangement paths with respective swapping indicators are overlapping.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 42 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

During a telephone conversation with Attorney Adam H. Masia on 3/22/2007 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-11, 21-22, 42-48, and 57-58. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-20, 23-41, and 49-56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 22 recites the broad recitation "any award," and the claim also recites "for each winning combination" which is the narrower statement of the range/limitation. Examiner further believes that

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there is no support for "any award" in claim 1 from which claim 22 depends, but only support for a first and second award.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-6, 10-11, 21-22, 42-43, 45-48, and 57-58 are rejected under 35 U.S.C. 102(b) as being anticipated by White et al. (US 6,855,054, hereinafter White).

Claims 1, 5-6, 10-11, 21-22, 42-43, 45-48, and 57-58 recite either a gaming device or method of operating a gaming device as follows:

1. A gaming device (column 6, lines 43-45, White) comprising:
a game operable upon a wager by a player (column 1, lines 28-30, White);
a plurality of reels in the game (column 1, lines 28-33, White);
a plurality of fixed positions on said reels (column 2, lines 57-67, White);
a plurality of symbols (column 7, lines 28-32, White), each of said symbols located at one of the positions on the reels (column 7, lines 36-39, White; the positions are clearly indicated as fixed since located in a matrix);

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a plurality of swapping indicators associated with at least three symbols (column 10, lines 56-65, White; the symbol indicating interchange is part of the plurality of symbols to be interchanged); and

a processor operable to (column 6, lines 43-45, White):

a) spin the reels to display a plurality of the symbols at their fixed positions on the reels (column 6, lines 14-20 and column 7, lines 33-36, White; the plural symbols at fixed positions on the reels are displayed during movement or spinning of the reels),

b) provide a first award to the player for each winning combination of displayed symbols (column 7, lines 40-48 and column 7, line 67 to column 8 line 3, White; after spinning the reels, the player's winning payline is visually perceptible and awards are provided for winning combinations),

c) determine if the swapping indicators associated with the at least three symbols are displayed and are in a predetermined configuration to indicate the symbols to be rearranged (column 9, lines 60-64, White; the symbol indicating interchange is part of the symbol set that is displayed and configuration determined prior to rearrangement), and, if so, rearrange each of the indicated symbols to fixed positions of the other indicated symbols (column 9, line 65 to column 10, line 2, White), and

(d) provide a second award to the player for each winning combination of displayed symbols which includes the rearranged indicated symbols (column 7, lines 55-59, White).

5. The gaming device of Claim 1, wherein the predetermined configuration of the swapping indicators includes a predetermined number of said swapping indicators (column 10, lines 56-65, White; the symbol or symbols indicating interchange are selected before interchange).

6. The gaming device of Claim 1, wherein the number of indicated symbols is predetermined (column 7, lines 28-32, White; symbols to be rearranged are generated prior to rearrangement).

10. The gaming device of Claim 1, wherein each indicated symbol is first rearranged to the fixed position of the indicated symbol directly adjacent to said indicated symbol (column 9, line 65 to column 10, line 2 and Fig. 7A, White).

11. The gaming device of Claim 1, wherein the processor is operable to provide the second awards to the player for each winning combination of the displayed symbols after each rearrangement of the indicated symbols (column 7, lines 55-59, White).

21. The gaming device of Claim 1, wherein the processor is operable to rearrange the indicated symbols and determine any winning combination of displayed symbols for each rearrangement until the indicated symbols are rearranged to their first fixed positions on the reels (column 4, lines 28-49, White).

22. The gaming device of Claim 1, wherein the processor is operable to provide any award for each winning combination resulting from each rearrangement of the indicated symbols (column 7, line 67 to column 8 line 3, White; awards are provided inherently for winning combinations based on rearrangement or an initial winning payline configuration).

42. A method of operating a gaming device, said method comprising the steps of:

- (a) displaying a plurality of reels (column 6, lines 14-20, White), wherein each of a plurality of symbols is displayed at a fixed position on said plurality of reels (column 2, lines 57-67, column 6, lines 14-20 and column 7, lines 33-36, White; the plural symbols at fixed positions on the reels are displayed during movement or spinning of the reels);
- (b) associating a plurality of swapping indicators with the plurality of symbols (column 10, lines 56-65, White; the symbol indicating interchange is part of the plurality of symbols to be interchanged);
- (c) spinning the reels to display a plurality of the symbols at the fixed positions on the reels (column 1, lines 28-33 and column 7, lines 36-39, White; the positions are clearly indicated as fixed since located in a matrix);

(d) providing a first award to the player for each winning combination of the displayed symbols (column 7, lines 40-48 and column 7, line 67 to column 8 line 3, White; after spinning the reels, winning payline is displayed to the player and awards are provided for winning combinations);

(e) indicating a plurality of displayed symbols if the swapping indicators associated with said displayed symbols are in a predetermined configuration to indicate the symbols to be rearranged (column 9, lines 60-64, White; the symbol indicating interchange is part of the symbol set that is displayed and configuration determined prior to rearrangement so as to indicate the plural symbols to be rearranged), and rearranging each of the indicated symbols to a fixed position, wherein each of the indicated symbols is moved to fixed positions of the other indicated symbols (column 9, line 65 to column 10, line 2, White); and

(f) providing a second award to the player for each winning combination of the displayed symbols which includes the rearranged indicated symbols (column 7, lines 55-59, White).

43. The method of Claim 42, wherein rearranging the indicated symbols includes moving each of the indicated symbols to a predetermined number of fixed positions which are different from its first fixed position (column 9, line 65 to column 10, line 2 and Fig. 7A, White; the position that each indicated symbol moves to is different than the first position it occupied).

45. The method of Claim 42, wherein rearranging the indicated symbols includes first moving each of the indicated symbols to the fixed position of the indicated symbol directly adjacent to each of said indicated symbols (column 9, line 65 to column 10, line 2 and Fig. 7A, White).

46. The method of Claim 45, wherein the fixed position of the indicated symbol adjacent to each of said indicated symbols is counter-clockwise from the fixed position of the indicated symbol (column 10, lines 2-5 and Fig. 7A, White; each fixed position of

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the path carrying a symbol is inherently clockwise or counter-clockwise since the path wraps around).

47. The method of Claim 42, wherein providing the second award to the player for each winning combination of the displayed symbols occurs after each rearrangement of the indicated symbols (column 7, lines 55-59, White).

48. The method of Claim 42, which includes rearranging the indicated symbols and providing the second award to the player for each winning combination of the displayed symbols after each rearrangement until each indicated symbol is moved to its first fixed position on the reels (column 4, lines 28-49, White).

57. The method of Claim 42, wherein the steps (a) to (f) are provided to the player through a data network (column 11, lines 46-50, White).

58. The method of Claim 57, wherein the data network is an internet (column 11, lines 46-50, White).

Every feature of claims 1, 5-6, 10-11, 21-22, 42-43, 45-48, and 57-58 is found in White. Thus, claims 1, 5-6, 10-11, 21-22, 42-43, 45-48, and 57-58 are anticipated by White.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-4, 7-9 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of McClintic (US Patent 6,905,405).

White discloses a gaming device as discussed supra. McClintic discloses a similar gaming device teaching that movement of symbol carriers, associated indicators or the combination thereof is important for visual representation of game operation (column 2, line 63 to column 3, line 4, McClintic). McClintic also suggests that symbol indicators may perform various motions or operations to enhance player enjoyment and improve the gaming experience (column 9, lines 5-8, McClintic).

The claimed features of claims 2-4, 7-9 and 44 that are lacking in White, but taught by McClintic are as follows:

2. The gaming device of Claim 1, wherein each swapping indicator includes a portion of the predetermined configuration (column 8, lines 44-59 and Fig. 6A, McClintic; the symbol indicator is chosen as part of the symbol configuration including the symbol carrier with symbol thereon).

3. The gaming device of Claim 1, wherein the predetermined configuration of the swapping indicators includes matching swapping indicators (column 11, lines 25-43 and Fig. 8, McClintic; the number of chosen indicators with respect to a symbol carrier must inherently match so as to determine different, feasible combinations since the indicators are mutually inclusive and appear to match on common paylines).

4. The gaming device of Claim 1, wherein the predetermined configuration of the swapping indicators includes an alignment of swapping indicators on adjacent reels (column 11, lines 25-43 and Fig. 8, McClintic; the indicators appear to align with common symbols on different paylines corresponding to adjacent reels).

7. The gaming device of Claim 1, wherein at least two of the indicated symbols are on different reels (column 2, lines 31-35 and Fig. 8, McClintic; more than two indicators are on different reels).

8. The gaming device of Claim 1, wherein at least two of the indicated symbols must be on different paylines associated with the reels (column 2, lines 31-35 and Fig. 8, McClintic; more than two indicated symbols are on different paylines associated with reels).

9. The gaming device of Claim 1, wherein the processor is operable to rearrange each indicated symbol in a counter-clockwise rotational fashion (column 8, lines 53-59, McClintic; counter to rotation is inherently clockwise or counter-clockwise).

44. The method of Claim 42, wherein rearranging the indicated symbols includes moving each indicated symbol in a counter-clockwise rotational fashion (column 8, lines 53-59, McClintic; counter to rotation is inherently clockwise or counter-clockwise).

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Thus, one having ordinary skill in the art at the time the applicant's invention was made would have been motivated to modify White in view of the teachings of McClintic to obtain the features related to symbol indicators, symbols, symbol carriers, reels and paylines in order to enhance player enjoyment and improve the gaming experience.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

C US-6,988,947 B2, Baerlocher et al.

D US-6,315,663 B1, Sakamoto

E US-6,602,136 B1, Baerlocher et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur O. Hall whose telephone number is (571) 270-1814. The examiner can normally be reached on Mon - Fri, 8:00am - 5:00 pm, Alt Fri, EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AH

3/27/2007


TU HOANG
PRIMARY EXAMINER